

OCT 28 2002
RECEIVED
TRADEMARK OFFICE

AF 2700

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
GEM-02703/03

Re Application Of: Levine

Serial No.
08/710,645

Filing Date
Sept. 18, 1996

Examiner
R. Brown

Group Art Unit
2611

Invention: TELEVISION SYSTEM MODULAR WITH REMOTE CONTROL CODE DETERMINATION

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

The fee for filing this Appeal Brief is: \$320.00

RECEIVED
OCT 30 2002
Technology Center 2600

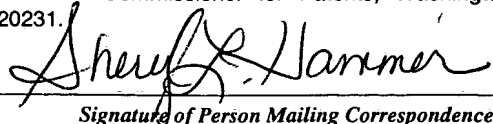
- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. A duplicate copy of this sheet is enclosed.


Signature

Dated: Oct. 21, 2002

John G. Posa
Reg. No. 37,424
Gifford, Krass, Groh et al
280 N. Old Woodward Ave., Suite 400
Birmingham, MI 48009
Tel. 734/913-9300

I certify that this document and fee is being deposited on 10-21-02 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.


Signature of Person Mailing Correspondence

Sheryl L. Hammer

Typed or Printed Name of Person Mailing Correspondence

CC:



#15
BA 11/7/02

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re application of: Levine

Serial No.: 08/710,645

Group No.: 2611

Filed: Sept. 18, 1996

Examiner: R. Brown

For: TELEVISION SYSTEM MODULAR WITH REMOTE CONTROL CODE
DETERMINATION

RECEIVED

OCT 30 2002

APPELLANT'S BRIEF UNDER 37 CFR §1.192

Technology Center 2600

I. Real Party in Interest

The real party and interest in this case is Gemstar Development Corporation of Pasadena, California, through assignment by the inventor, Michael R. Levine.

II. Related Appeals and Interferences

There are no related appeals or interferences known to Appellant or Appellant's legal representative affected by, or which might have a bearing, on the Board's decision with respect to this appeal.

III. Status of the Claims

Claims 1-22 are pending in this application, all are under final rejection.

IV. Status of all Amendments Filed Subsequent to Final Rejection

No after-final amendments have been filed.

V. Concise Summary of the Invention

The present invention is directed toward a modular unit adapted for use in conjunction with one or more remotely controllable units associated with television recording and/or viewing (Specification, column 1, lines 61-65). In a preferred embodiment, the "master" modular unit constitutes a video

11/07/2002 BAXAND 00000002 08710645

01 FC:1402

320.00 OP

10/28/2002 CNGUYEN 00000089 09710645

01 FC:1402

320.00 OP

11/07/2002 BAXAND 00000002 08710645
CNGUYEN 00000089 09710645

recorder and the following description will refer to a video recorder with the understanding that another unit, such as the cable box, could act as the master (Specification, column 1, line 65 to column 2, line 2). The video recorder "master" contains a remote-control signal transmitter to transmit control codes to one or more associated "slave" units, and means to analyze the operation of the associated units in response to the control codes (Specification, column 2, lines 2-7). During an initialization routine, an electronic controller causes the master transmitter to send test codes to the associated unit, then analyzes the resulting operation of the associated unit to determine its control codes, which it stores in a memory for later use in control of the associated unit (Specification, column 2, lines 7-12).

In a preferred embodiment, the associated unit contains a multi-channel tuner, another video recorder is adapted to receive and analyze the R.F. output signal from the tuner to determine its operation in response to the test control codes (Specification, column 2, lines 13-17). When the associated unit is a cable tuner/descrambler, the video recorder derives a video signal from the R.F. output of the tuner/descrambler and analyzes the synchronization of the video signal to identify the tuned channel (Specification, column 2, lines 17-21). When the associated unit is a television receiver, the video recorder is adapted to receive and analyze an acoustic signal generated by the T.V. (Specification, column 2, lines 22-24).

Before the video recorder can analyze the control codes of associated units it must make a determination as to whether it is receiving a signal source from an auxiliary unit which provides output on only a single channel or if it is connected directly to a multi-channel signal source such as a cable (Specification, column 2, lines 25-30). Means are provided for automatically analyzing the nature of its input signal to make this determination as the first operation in its initialization routine (Specification, column 2, lines 30-34).

VI. Concise Statement of Issues Presented for Review

A. Are claims 1-22 anticipated under 35 U.S.C. §103(a) over Furrey (U.S. Patent No. 6,049,653) in view of Amano (U.S. Patent No. 4,999,622)?

VII. Grouping of Claims for Each Ground of Rejection Which Appellants Contend

Appellant believes the following three groups of claims represent patentably distinct subject matter warranting independent consideration by the Board:

Group I: Claims 1-10, wherein claims 2-10 stand or fall with claim 1.

Group II: Claims 11-15, wherein claims 12-15 stand or fall with claim 11.

Group III: Claims 16-22, wherein claims 17-22 stand or fall with claim 16.

VIII. Argument

Group I: Claims 1-10

Claims 1 was rejected under 35 U.S.C. §103(a) over Furrey (U.S. Patent No. 6,049,653) in view of Amano (U.S. Patent No. 4,999,622). Furrey is directed to a VCR including means for controlling a cable converter unit. In a preferred embodiment, infrared (IR) transmission of commands from the VCR to the cable converter unit is employed. Due to the fact that more IR power should be directed along a path away from the unit to be controlled (i.e., along a "bounce" path) than needs to be directed toward the unit to be controlled, an LED assembly holds the LEDs in a predetermined orientation and provides first and second IR ports through which different amounts of IR signals are transmitted.

With respect to instant claim 1, the Examiner is correct that Furrey teaches a VCR operative to determine whether a receiving unit has executed commands that have been transmitted. The Examiner is also correct that Furrey teaches that one of the operations of the associated unit is to detect whether the cable box has been turned ON or OFF, but does not explicitly teach that the energization codes for the associated unit are stored in the VCR.

Amano resides in a multi-commander (i.e., hand-held remote control) that is easily expandable in capacity and one that can be actuated in a short period of time and with high accuracy. To meet this objective, the apparatus of Amano includes a first memory for storing a plurality of remote control signals having different signal formats, a circuit for receiving a remote control signal from another remote commander, a rewritable second memory, a remote control signal transmitting circuit for transmitting a remote control signal derived from the first memory, and a mode switch for selectively switching between the setting mode and the remote control mode. When the mode switch is in the

setting mode, the signal format of the remote control signal derived from the other remote commander and received by the remote control signal receiving circuit is identified and the signal format of the remote control signal from the other remote commander is read out of the first memory and is then written in the second memory. When the mode switch is in the remote control mode, the signal format written in the second memory is supplied to the remote control signal transmitting circuit in order to control a selected one of a plurality of electronic devices.

Although Amano teaches the storage of "switch-on" or energization codes for manufacturers in a remote commander, the Examiner draws the conclusion that it would have been obvious to one of ordinary skill in the art to modify Furrey with the feature disclosed in Amano "for the known advantage of a more flexible system which is enabled to control a wider range of associated units." Appellant respectfully disagrees with this conclusion.

In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, it is not the goal of Furrey to energize associated units, but rather, to make certain that codes already stored are received. Presumably, if it is determined that VCR is not receiving the appropriate signal from the cable box, it is up to the user to turn the cable box ON. The Board's attention is directed to column 4, lines 49-54 of Furrey, wherein it is stated that "an electrically-erasable programmable RAM (EEPROM) serves as non-volatile storage with respect to channel data, user-entered channel data and VCR Plus® channel mapping data." This would have been the opportunity for Furrey to indicate the desirability of also storing energization codes, but Furrey did not take this opportunity, because the VCR/cable box combination with respect to the Furrey invention are set up as a unit, and not intended to "learn" the energization code associated with the cable box. This is in marked contrast to Appellant's invention, which is specifically intended (and claimed) for use with

equipment from various manufacturers, to initially determine whether an associated unit has been turned on or off such that, from that point on, more specific control functions may be recognized and stored.

Group II: Claims 11-15

Claim 11, a method claim, includes certain steps which are specifically performed each time a T.V. module is energized. These steps include transmitting task control codes to an associated unit, analyzing without operator intervention the resulting operation of the associated unit in order to determine its control codes and storing the control codes in a memory. The Ex does not discuss the rejection of this claim with any specificity, such that the only conclusion to be drawn is that the claim and those which depend therefrom are allowable. The only comment made by the Ex in this regard is that "finally the step of causing the control code determined to be related to the associated unit to be stored in memory reads on Amano, since once it is determined that the T.V. or VCR is turned on due to the control code, than the particular control code is stored in RAM of the remote control," citing column 5, lines 9-12; column 6, lines 60-65; and column 7, lines 1-35. However, given that Amano resides in a remote commander or remote control unit that is programmable for a new piece of hardware, it is clear to one of any skill in the art that this is preferably only done once, namely, at the time the hardware is added, and clearly not each time that the T.V. module is energized. Such teaches away from obviousness, since the test performed would unnecessarily redundant and time-consuming.

Group III: Claims 16-22

Claim 16, an independent apparatus claim, sets forth a T.V. module adapted for use with a remotely controllable T.V. receiver. The apparatus includes an electronic controller operative to transmit a test control signal to the television receiver, and analyze the operation of the receiver to determine control codes related to the television receiver, and cause the control codes to be stored in a memory. As with the other claims of this application, the Furrey et al./Amano combination is relied upon. However, as the Board will see, Furrey et al. is specifically directed to a VCR operative to control a cable box, with no teaching or suggestion with regard to a television receiver. Accordingly, even if the Furrey et al./Amano combination were appropriate, which Appellant argues it is not, the claims of this group would not result.

Conclusion

Furrey et al., even in combination with Amano, accordingly does not teach the limitations of Appellant's independent claims 1, 11 and 16. *Prima facie* obviousness has therefore not been established.

Respectfully submitted,

By: 

John G. Posa

Reg. No. 37,424

Gifford, Krass, Groh et al

280 N. Old Woodward Ave., Ste 400

Birmingham, MI 48009

(734) 913-9300 FAX (734) 913-6007

Date: Oct. 21, 2002

APPENDIX AAppended Claims

1. A T.V. module adapted for use in conjunction with a remotely controllable associated unit, comprising:
 - a remote-control signal transmitter adapted to transmit signals representative of control codes to the associated unit;
 - means adapted to analyze the operation of said associated unit in response to said control codes;
 - a memory operative to store remote-control codes including the energization codes for associated units provided by a variety of manufacturers; and
 - an electronic controller means operative to perform the following functions:
 - cause said remote-control signal transmitter to transmit test control signals to said associated unit,
 - cause said means adapted to analyze the operation of said associated unit to determine whether the associated unit has been energized in response to said test control codes, and
 - cause the control codes determined to be related to the associated unit to be stored in said memory.
2. The invention of claim 1 in which the T.V. module is a video recorder.
3. The T.V. module of claim 1 wherein the associated unit is a cable tuner/descrambler.
4. The T.V. module of claim 1 wherein the associated unit is a satellite receiver.
5. The T.V. module of claim 1 wherein the associated unit is a video recorder.
6. The T.V. module of claim 1, further including means adapted to receive an output signal from the associated unit, said controller being operative to analyze the output signal in order to determine the operation of the associated unit in response to said test control-code signals.

7. The T.V. module of claim 6 wherein said output signal is a video signal.

8. The T.V. module of claim 7 wherein said controller is operative to analyze the synchronization of said video signal.

9. The T.V. module of claim 1, further comprising a connected T.V. receiver, means to receive an output signal from the receiver, wherein the controller is operative to cause the transmitter to transmit test control-code signals to the receiver; analyze the resulting operation of the receiver in order to determine control codes for the receiver; and store the control codes for the receiver in said memory.

10. The T.V. module of claim 9 wherein said controller is further connected to an audio sensor operative to receive an acoustic signal from said receiver, and to detect a variation in said acoustic signal.

11. In a T.V. module adapted for use in conjunction with a remotely controllable associated unit, the T.V. module including a remote-control signal transmitter adapted to transmit control signals to the associated unit; means for analyzing the operation of the associated unit; and a memory adapted to store remote-control codes, the method of determining control codes for the associated unit, comprising the following steps, which are performed each time the T.V. module is energized:

transmitting test control codes to the associated unit;

analyzing without operator intervention the resulting operation of the associated unit in order to determine its control codes; and

storing the control codes in a memory.

12. The method of claim 11 wherein the step of electronically analyzing the resulting operation of the associated unit in order to determine its control codes includes the step of analyzing an output signal from the associated unit.

13. The method of claim 12 wherein the step of analyzing said output signal includes the step of analyzing a video signal.

14. The method of claim 13 wherein the step of analyzing a video signal includes the step of analyzing the synchronization of said video signal.

15. The method of claim 14 wherein the step of analyzing said output signal includes the step of analyzing an acoustic signal.

16. A T.V. module adapted for use in conjunction with a remotely controllable T.V. receiver, comprising:

a remote-control signal transmitter adapted to transmit signals representative of control codes to the T.V. receiver;

means adapted to analyze the operation of said T.V. receiver in response to said control codes;

a memory operative to store remote-control codes; and

an electronic controller means operative to perform the following functions:

cause said remote-control signal transmitter to transmit test control signals to said T.V. receiver,

cause said means adapted to analyze the operation of said T.V. receiver to determine control codes related to the T.V. receiver in response to said test control codes, and

cause the control codes determined to be related to the T.V. receiver to be stored in said memory.

17. The apparatus of claim 16 in which the T.V. module is a video recorder.

18. The apparatus of claim 16 wherein the T.V. module is a cable tuner/descrambler.

19. The apparatus of claim 16 wherein the T.V. module is a satellite receiver.

20. The apparatus of claim 16 wherein the T.V. module is a video recorder.

21. The T.V. module of claim 16, further including means adapted to receive an output signal from the T.V. receiver, said controller being operative to analyze the output signal in order to determine the operation of the T.V. receiver in response to said test control-code signals.

22. The T.V. module of claim 16 wherein said controller is further connected to an audio sensor operative to receive an acoustic signal from said receiver, and to detect a variation in said acoustic signal.